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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,665	07/09/2003	Shiying Zheng	KPG-5081US	9324
31344	7590	03/22/2005	EXAMINER	
RATNERPRESTIA P.O. BOX 1596 WILMINGTON, DE 19899			GILLIAM, BARBARA LEE	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,665

Applicant(s)

ZHENG ET AL.

Examiner

Barbara L. Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment filed 12/30/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-14,16-20,25-32 and 34-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-14,16-20,25-32 and 34-36 is/are allowed.
- 6) ☒ Claim(s) 37-43 and 45-48 is/are rejected.
- 7) ☒ Claim(s) 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed December 30, 2004 has been entered and fully considered.
 2. All previous rejections are withdrawn.
 3. Claims 1, 3-14, 16-20, 25-32, 34-48 are present of which 36-48 are new.
- Claims 2, 15, 21-24, and 33 were canceled by Applicant.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 37-43 and 45-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Yanaka (JP 2002-002135).

- a. The original film for lithographic printing taught by Yanaka et al. clearly anticipates the present imageable element. Specifically the film has a heat-sensitive layer containing microcapsules containing a hydrophobic resin on substrate having a hydrophilic surface (abstract), wherein the hydrophobic resin can be a polyurethane resin ([0013]). The microcapsules have a mean diameter of 0.01 – 20 micrometers and are preferably used in an amount of ten to 50% by weight of the heat-sensitive layer ([0017]-[0018]). The polyurethane microcapsules meet the present limitations for the polyurethane particles. A hydrophilic resin can be added to the heat-sensitive layer in

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an amount of 5-40 % by weight of the layer ([0022]-[0024]). This hydrophilic resin meets the present limitations for the water soluble polymer. The light-heat conversion agent is added to the heat-sensitive layer in an amount of 5 – 25 weight % ([0036]). A surfactant can be added to the heat-sensitive layer in the amount of 0.05 – 0.5 weight % ([0048]). After imagewise recording by heat, the precursor can be subjected to on-machine development using ink and dampening water ([0063]).

b. The particles of claims 37-43 and 45-48 “consist essentially of the polyurethane polymer.” Applicant is reminded that “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). MPEP 2111.03. There is no indication that the other components of the particles disclosed by Yanaka would affect the basic and novel characteristics of the claimed invention..

Allowable Subject Matter

6. Claims 1, 3-14, 16-20, 25-36 are allowed.

a. The following is a statement of reasons for the indication of allowable subject matter: The claims are allowable in light of the claims amendments and Applicant’s persuasive arguments.

7. Claim 44 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

a. The following is a statement of reasons for the indication of allowable subject matter: There is no teaching or suggestion in either Yanaka (EP 1 203 660) or Yanaka (JP 2002-002135) of preparing the polyurethane compound by reaction of a diisocyanate and a dihydroxy compound wherein the dihydroxy compound comprises about 1-25% of a carboxy functional diol or a mixture of carboxy functional diols.

Response to Arguments

8. Applicant's arguments, see pages 10-12, filed December 30, 2004, with respect to the rejections of claims 1-35 under 35 USC 102(b) have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in light of new claims 37-48.

9. In light of new claims 37-48, Applicant argued that new independent claims each recite that "the particles consist essentially of the polyurethane polymer" and that the use of microcapsules that consist essentially of a polyurethane polymer is neither disclosed nor suggested by Yanaka (JP 2002-002135) because the microcapsules taught therein also contain heat-light conversion agents, polyfunctional monomers and plasticizers. Applicant is reminded that "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be

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construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. MPEP 2111.03.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Barbara L. Gilliam

Barbara L. Gilliam
Primary Examiner
Art Unit 1752

bg
March 18, 2005